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In re Application of	:	
ARTHUR, et al.	:	
PCT No.: PCT/AU03/00300	:	DECISION ON PETITION
Application No.: 10/507,257	:	
Int. Filing Date: 13 March 2003	:	UNDER 37 CFR 1.497(d)
Priority Date: 13 March 2002	:	
Atty. Docket No.: 3170.1006-000	:	
For: ANNOTATION OF GENOME SEQUENCES	:	

This decision is in response to applicant's "Reply to Notification of Missing Requirements" filed 27 April 2005 in the United States Patent and Trademark Office (USPTO). For the reasons discussed below, the filing of the declaration is being treated as a request under 37 CFR 1.497(d).

### **BACKGROUND**

On 13 March 2003, applicant filed international application PCT/AU03/00300, which claimed priority of an earlier application filed 13 March 2002. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 18 September 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 13 September 2004.

On 10 September 2004, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and a First preliminary amendment.

On 28 February 2005, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide an executed oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. Applicant was afforded two months or by 32 months from the priority date whichever was later to respond.

On 27 April 2005, applicant filed the declaration discussed herein.

### **DISCUSSION**

A review of the filed declaration finds that it does not comply with 37 CFR 1.497(a)-(b). Specifically, the filed declaration sets forth an additional inventor, Mathew Danger Traini who is not named in the international application. In order to proceed with national stage processing applicant is required to file either: 1) a submission under 37 CFR 1.497(d) requesting correction of the inventors named in the international application to include Mr. Traini, (2) a new declaration naming and signed by only Jonathan Wesley Arthur and Marc Wilkins accompanied by an acceptable explanation of the misnaming of the inventor on the present declaration, or (3) a showing that a change under PCT Rule 92bis was made prior to the National stage filing, i.e. a copy of form PCT/IB/306.

Applicant is advised that a request under 37 CFR 1.497(d) [formally, 37 CFR 1.48] to correct an error in naming inventorship requires:

- (1) a petition including a statement from each person being added or deleted as an inventor that the error in inventorship occurred without any deceptive intention on his or her part;
- (2) an oath or declaration by the actual inventor(s) as required by 37 CFR 1.63;
- (3) the fee set forth in 37 CFR 1.17(i); and
- (4) if an assignment has been executed by any of the original named inventors, the written consent of the assignee in compliance with 37 CFR 3.73(b).

As it is not clear at this time whether the additional inventor was added during processing of the international application, the required petition fee will not be charged to applicant's deposit account at this time.

In light of the above, it is not possible to grant applicant's petition at this time.

### **CONCLUSION**

For the reasons above, applicant's request under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

Applicant is hereby afforded **TWO (2) MONTHS** from the mail date of this decision to file any request for reconsideration. Any reconsideration request should include a cover letter entitled, "Response to Decision Under 37 CFR 1.497(d)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

A handwritten signature in black ink, appearing to read 'D. A. Putonen', written in a cursive style.

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